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10/630,282	07/30/2003	Richard Martin Jacobson	A01395	9705
7590 04/29/2008 Rohm and Haas Company 100 Independence Mall West Philadelphia, PA 19106				
EXAMINER				
QAZI, SABIHA NAIM				
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/630,282  
Filing Date: July 30, 2003  
Appellant(s): Richard Martin Jacobson et al.

\_\_\_\_\_  
Thomas D. Rogerson  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed October 15, 2007 appealing from the Office action mailed February 14, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is incorrect.

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

Double Patenting rejection over US Patent 7,041,625 and US Patent 6,770,600 is withdrawn.

Rejection under 35 U.S.C. 103 (a) over SEYFRETH (US Patent 3,265,745) is withdrawn.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Baird, M. S. "A new Approach to Cyclopropene Fatty Acids involving 1, 2-Deiodination", J. Chem. Soc. Perking Trans., vol. 14, pages 1547-1548, 1993.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**Claim Rejections - 35 USC § 103**

Claims 2-4 are rejected under 35 U.S.C. 103 (a) as being unpatentable of BAIRD et al. (J. Chem. Soc. Perkin Trans 1, 1986, pp 1845-1853). Baird teaches structurally similar cyclopropane derivatives containing halogens and halogens include F, Cl, Br and I. See the entire document. Baird further teaches addition of substituents to cyclopropene compound 11 by addition of bromine in carbon tetrachloride led to compound 12, see reaction scheme of compounds 10-17, in column 1 on page 1846 of the reference.

Instant claims differ from the reference in claiming a broad range of cyclopropane compounds as in claim 2 where in prior art teaches a limited genus containing halogen substituted cyclopropanes.

It would have been obvious to one skilled in the art at the time of invention to prepare additional cyclopropane compounds containing halogenated cyclopropanes, even if the reference does not disclose iodo specifically, one skilled in the art would select any halogen as a substituents on cyclopropanes as needed because halogens belong to the same group in the periodic table (VII group) and expected to possess similar properties. Halogen includes F, Cl, Br and I. Since there is no showing any criticality or advantages by selecting iodo over other halogens the presently claimed invention is considered obvious at the time the invention was made.

Since prior teaches these compounds it would have been obvious to select any halo atom such as iodo at both positions. A proviso in claim 1 when at least one of W1 and W1 can be I have been noted, however, there is no showing of any unexpected and/or unobvious results of the presently claimed invention.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might reasonably infer from the teachings. *In re opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA 1976). A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982).

Accordingly, the burden of proof is upon applicants to show that instantly claimed subject matter is different and unobvious over those taught by prior art. See *In re Brown*, 173 USPQ 685, 688; *In re Best*, 195 USPQ 430 and *In re Marosi*, 218 USPQ 289, 293.

In absence of any criticality and/or unexpected results presently claimed invention is considered obvious over the prior art.

#### **(10) Response to Argument**

Appellant argue that there is no motivation from BAIRD reference to prepare presently claimed compounds because there is no disclosure, teaching, or suggestion that the halogen can be iodo and a proviso in Appellants claim 2 requires at least one iodo substituent (W1 or W2) and BAIRD does not teach iodo, it teaches halogen as Br or Cl. The Examiner disagrees with the arguments because first Baird does teach halogens and halogens include F, CL, Br and I. Even though the reference does not disclose iodo specifically, one skilled in the art would select any halogen as a substituents on cyclopropanes as needed because halogens belong to the same group in the periodic table (VII group) and expected to possess similar properties. Since Appellants have not shown any criticality or advantages for selecting iodo over other halogens the presently claimed invention is considered obvious at the time the invention was made.

Appellant argue that compounds are different because the method of making BAIRD cyclopropanes are different from present invention. The Examiner disagrees because Appellants are not claiming the method for making the compounds as has been argued, they are claiming substituted cyclopropane compounds which are taught by the reference. In the present case the compounds as claimed would have been obvious to one skilled in the art at the time the invention was made in view of the teachings of the prior art available to one skilled in the art. No criticality of invention and/or unexpected results is disclosed by the Applicant.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Sabiha Qazi/

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